

REMARKS

Upon entry of the claim amendments, claims 6-11 are all the claims pending in the application. Claims 1-5 have been canceled, and claims 6-10 are amended. Moreover, new claim 11 has been introduced. Support for the claim amendments and the new claim can be found throughout the specification and originally filed claims.

Specifically, claims 6-8 are amended to recite “the dried fibrous fish meat-bound food can be rehydrated with hot water and consumed.” Support for the amendments to claims 6-8 can be found in at least the abstract and at pages 11-13.

Claims 8 and 9 are also amended to simplify the claim language.

Claim 10 is amended to remove its dependency from multiple dependent claim 9.

New claim 11 has been introduced to cover the subject matter deleted by removing claim 10's dependency from claim 9.

Accordingly, no new matter has been introduced by these amendments to the claims.

I. Claim Objections

Claims 5 and 10 are objected to under 37 C.F.R. 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim.

The objection is moot as to canceled claim 5.

Further, Applicants have amended claim 10 to remove its dependency from multiple dependent claim 9.

Accordingly, Applicants respectfully request that the above objection to claim 10 be reconsidered and withdrawn.

II. Claim Rejections-35 U.S.C. § 112

Claims 3, 5, 8, and 10 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite.

1. Regarding Claims 5 and 10, the Examiner contends that the term “excellent” is a relative term which renders the claim indefinite.

The rejection is moot as to canceled claim 5.

Regarding “excellent in form retention property,” as recited in claim 10, Applicants direct the Examiner to page 12 of the specification, which states “the physical properties thereof depend on the properties of the meat paste for binding use, which exert influences upon the form retention property (flake generation ratio) … physical properties of the meat for binding after heating are increased and the flake generation ratio is decreased,” and page 17, which states, “[t]he flake generation ratio was about 5.0%.” Thus, from reading the specification, one of ordinary skill in the art would understand the meets and bounds of the phrase, “excellent in form retention property.”

Furthermore, regarding “excellent in hot water-rehydration property,” page 13 of the specification states, “it can be regarded to have a good hot water-rehydration property when the wet weight/dry weight is 3 or more.” Thus, from reading the specification, one of ordinary skill in the art would understand the meets and bounds of the phrase, “excellent in hot water-rehydration property.”

2. Regarding Claims 3 and 8, the Examiner contends that the phrase, “allowing any one of the fish meat protein molded into a fibrous form by acid denaturation,” does not have any meaning because the statement is incomplete. The Examiner further asserts that when this

statement is read, the reader is not informed what the fish meat protein molded into a fibrous form by acid denaturation is allowed to do.

Claim 3 has been canceled.

As to claim 8, Applicants respectfully submit that the Examiner has mistakenly misread the claim. Claim 8, in fact, recites “allowing any one of the fish meat protein molded into a fibrous form by acid-denaturation, the fish meat paste and a mixture thereof to have a buffer function for thereby adjusting a pH thereof to from 6.7 to 7.5” (emphasis added) and thus are complete as proper claims.

Nonetheless, Applicants simplified the language of claim 8 by deleting the phrase, “molded into a fibrous form by acid-denaturation,” and reciting “the molded fish meat protein” instead.

Accordingly, Applicants respectfully request that the above rejection under 35 U.S.C. § 112, second paragraph, be reconsidered and withdrawn.

III. Claim Rejections-35 U.S.C. § 103

1. Claims 1-5 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishimura *et al.* (US Pat. No. 4584204; “Nishimura”) in view of Okada (US Pat. No. 4559236).

Applicants have canceled claims 1-5 solely to expedite the prosecution.

Applicants respectfully submit that the current cancellations of claims 1-5 render moot the above rejections and request that this rejection under 35 U.S.C. § 103 be withdrawn.

2. Claims 6-10 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Nishimura *et al.* (US Pat. No. 4584204; “Nishimura”) in view of Okada (US Pat. No. 4559236; “Okada ‘236”) and further in view of Okada (US Pat. No. 4880654; “Okada ‘654”).

In making the rejection, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the drying step as taught in Okada ‘654 with the method taught by Nishimura in view of Okada ‘236.

Applicants respectfully disagree.

Claims 6-8 have been amended to recite that “the dried fibrous fish meat-bound food can be rehydrated with hot water and consumed.” Applicants assert that the current amendments to claims 6-8 render moot this obviousness rejection, because the combination of the cited arts fails to teach each and every element of the presently claimed invention.

To establish a *prima facie* case obviousness the cited references must disclose all of the claim limitations. *In re Royka*, 490 F.2d 981, 984 (CCPA 1974). Applicants assert that the combination of Nishimura, Okada ‘236 and Okada ‘654 does not teach or suggest that “the dried fibrous fish meat-bound food can be rehydrated with hot water and consumed,” either explicitly or inherently.

Specifically, Nishimura and Okada ‘236 fail to teach or suggest that “the dried fibrous fish meat-bound food can be rehydrated with hot water and consumed” because Nishimura and Okada ‘236 do not teach any dried fibrous fish meat-bound food as recited in claims 6-8. The Examiner admits the deficiency of Nishimura and Okada ‘236 at page 5, the Office Action of April 3, 2009.

While Okada '654 is cited to cure the deficiency of Nishimura and Okada '236's deficiency, Okada '654 still does not teach or suggest that "the dried fibrous fish meat-bound food can be rehydrated with hot water and consumed" as recited in claims 6-8. Okada '654 discloses a salmon jerky dried product but is silent regarding any addition of water to rehydrate the dried product.

Accordingly, Applicants submit that the combination of the cited arts fails to teach "the dried fibrous fish meat-bound food can be rehydrated with hot water and consumed," as recited in independent claims 6-8. Since claims 9-10 are dependent upon claims 6, 7 and 8, Applicants submit that claims 9-10 are patentable at least by virtue of their dependency.

For the reasons set forth above, Applicants respectfully submit that the combination of cited references fails to teach or suggest each and every element of the present claims, either explicitly or inherently.

Moreover, with respect to claims 6-10, as MPEP § 716.02(a) states, "[e]vidence of unobvious or unexpected advantageous properties, such as superiority in a property the claimed compound shares with the prior art, can rebut *prima facie* obviousness. 'Evidence that a compound is unexpectedly superior in one of a spectrum of common properties . . . can be enough to rebut a *prima facie* case of obviousness.' ... *In re Chupp*, 816 F.2d 643, 646, 2 USPQ2d 1437, 1439 (Fed. Cir. 1987) ... [p]resence of a property not possessed by the prior art is evidence of nonobviousness. *In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963)."

Applicants further submit that the dried fibrous fish meat-bound food produced by the claimed method has an unexpectedly superior property of having a combination of form

retention property and hot-water-rehydration property, which are known as contradicting properties. Examples 1-3.

Therefore, Applicants submit that the claimed invention is not obvious over the combination of Nishimura, Okada '236 and Okada '654 because Applicants have shown unexpectedly superior results due to the synergistic effect of steps required by the claimed method.

For the foregoing reasons, Applicants respectfully submit that the claims are not rendered obvious by the cited references and request that this rejection under 35 U.S.C. § 103 be reconsidered and withdrawn.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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